

## **REMARKS**

Claims 1-17 are pending in the application. Claims 1, 15 and 16 have been amended. Claims 2 and 3 have been canceled without prejudice or disclaimer. Claim 17 is newly added. Reconsideration of this application is respectfully requested.

The Office Action rejects claims 1 and 13-16 under 35 U.S.C 103(a) as unpatentable over U.S. Patent No. 6,233,577 to Ramasubramani et al., hereafter Ramasubramani, in view of U.S Patent No. 6,347,398 to Parthasarathy et al., hereafter Parthasarathy. This rejection is moot since claims 1, 15 and 16 have been amended to incorporate the language of claims 2 and 3.

Moreover, Ramasubramani manages certificates, stores them and distributes them. According to the present invention, the "proxy" just forwards the request to the best available certificate authority (CA) but does not store or process certificates. The "proxy" according to the present invention acts more as a relay and a dispatcher than as a proxy. The same word is used but the function is different. In the present invention, the digital certificates are not stored locally. The certificate request is just stored and forwarded in one direction from client to the CA (and the certificate in the other direction from the CA to client). The storage is temporary and cannot be compared to the permanent storage of Ramasubramani. In contrast, amended claim 1 recites that the request is dispatched to the best certificate authority (CA) based on a list of anti-virus programs to be executed on the file.

Proxies are used for several protocols and services. However, the function of the proxy according to Ramasubramani and the function of the proxy according to the present invention are different. Ramasubramani manages and stores unlike the present invention. The proxy according to the present invention

receives the file (in the request) for which a certificate is requested and forwards it to the virus-free certificate authority. This is never the case in the proxy according to Ramasubramani. In the present invention, the file is not stored in the proxy and is not sent back by the certificate authority (CA) as the CA uses this file only to check it in order to build the corresponding certificate. Then the CA discards the file.

The Examiner alleges in the Office action dated March 18, 2004 that because Ramasubramani refers to a prior practice of physically storing the certificates in a local device, it would have been obvious to one of ordinary skill in the art to send back in response to the certificate request the received certificate. This allegation is erroneous. The purpose of Ramasubramani is to avoid the practice of local storage by storing all certificates in a proxy server (column 7, line 67, to column 8, line 6), so as to avoid the use of local computing power and memory. Thus, it would have been unobvious to make such a modification to Ramasubramani. Moreover, the proposed modification, by changing the purpose of Ramasubramani, would lack suggestion or motivation. See MPEP 2143.01 and cited cases. Accordingly, Ramasubramani lacks the step of sending back in response to the virus-free certificate request the received virus-free certificate.

The Examiner admits that Ramasubramani does not teach that the certificate is a virus-free certificate. The Examiner notes in the final Office Action that Parthasarathy discloses at column 8, lines 35-47, that a digital certificate can be used to ensure that a downloaded software component is safe (e.g., computer virus and corruption free) on a local computer. Parthasarathy checks a signature generated by a file originator or author. This signature is supposed to certify that the file is not corrupted and/or is virus free. The problem is that the file originator is not always a trusted entity. Furthermore, viruses are evolving rapidly. For these reasons, it is necessary to identify by whom, with what and at which level the checking of the signature has been performed otherwise this is just a signature and a certificate but not a trusted authority.

In contrast, the method recited in amended claim 1, comprises the step of selecting the trusted entity that has authority to generate a virus-free certificate for a file. Parthasarathy's authority is the originator of the software component and Parthasarathy's code verification module merely checks the digital signature of the file originator. There is no assurance that the software component has been checked with anti-virus programs. Thus, there is no teaching that the author has actually tested the software component with anti-virus programs. Thus, the author is not a Certificate Authority who can be trusted.

The Examiner concludes, based on the cited passage of Parthasarathy, that it would have been obvious to one of ordinary skill in the art to modify "Ramasubramani with the teaching of Parthasarathy to use a virus-free certificate with the motivation to provide dynamic and truly interactive multimedia to a user" citing column 3, lines 26 and 27 of Parthasarathy. This conclusion is erroneous. There is no teaching in either Ramasubramani or Parthasarathy to make such a modification. In fact, Ramasubramani and Parthasarathy have two entirely different purposes. Ramasubramani uses digital certificates to verify the authenticity of two communicating devices to one another. If the authenticity is verified, a communication session between the two devices is allowed. On the other hand, Parthasarathy uses a digital certificate signed by an author of a software component to be downloaded. There is no teaching or suggestion that the communication session of Ramasubramani would involve the downloading of any files. Accordingly, one of ordinary skill in the art would not be motivated to combine Ramasubramani and Parthasarathy as suggested by the Examiner.

For the reason set forth above, it is submitted that the rejection of claims 1 and 13-16 under 35 U.S.C. 103(a) is inapplicable and should be withdrawn.

The Office Action rejects claims 2-4 under 35 U.S.C 103(a) as unpatentable over Ramasubramani in view of Parthasarathy as applied to claim 1

and further in view of U.S Patent No. 6,574,663 to Bakshi et al., hereafter Bakshi. This rejection is moot since claims 2 and 3 have been canceled.

The Examiner admits that the combination of Ramasubramani and Parthasarathy does not teach that the virus-free certificate comprises a list of one or a plurality of anti-virus programs to execute on the file to determine whether the file is virus-free or not. The Examiner notes that "Bakshi teaches that when a new service (i.e., virus-free certificate) is needed in a network, a request may be sent identifying the type of the service (i.e., anti-virus program to execute) and a target device where the service is needed (see Bakshi, column 6, lines 50-56)." However, Bakshi does not in any way teach or suggest that the software component is a virus-free certificate or an anti-virus program as suggested by the Examiner's parenthetical notations. In fact, the Examiner's parenthetical notations are based on the hindsight of Applicants' application. Moreover, the cited passage of Bakshi merely refers to a new service request that "may identify the type of service and the target device where the service is needed". This in no way teaches the claimed request that comprises a list of one or a plurality of anti-virus programs to execute on the file to determine if the file is virus-free or not.

The Examiner contends that it would have been obvious to one of ordinary skill in the art to modify the combination of Ramasubramani and Parthasarathy with the teaching of Bakshi to include that the virus-free certificate request comprises a list of one or a plurality of anti-virus programs to execute on the file to determine if the file is virus-free or not. This contention is erroneous since Bakshi does not teach a request that comprises a list of one or a plurality of anti-virus programs to execute on the file to determine if the file is virus-free or not as discussed above.

The Examiner also admits that the combination of Ramasubramani and Parthasarathy does not teach that the virus-free certificate request does not comprise the file for which the virus-free free certificate is requested. The

Examiner notes that "Bakshi teaches that when a new service (i.e., virus-free certificate) is needed in a network, a request may be sent identifying the type of the service (i.e., anti-virus program to execute) and a target device (i.e., file) where the service is needed (see Bakshi, column 6, lines 50-56)." However, Bakshi does not in any way teach or suggest that the software components are a virus-free certificate or an anti-virus program or that the target device is a file as suggested by the Examiner's parenthetical notations. In fact, the Examiner's parenthetical notations are based on the hindsight of Applicants' application. Moreover, the cited passage of Bakshi merely refers to a new service request that "may identify the type of service and the target device where the service is needed". Moreover, the cited passage of Bakshi merely refers to a new service request that "may identify the type of service and the target device where the service is needed". This in no way teaches a request that comprises a file as claimed in amended claim 4.

In addition, there is no motivation for one skilled in the art to modify Ramasubramani to include the sending back step of claim 1 for the reason discussed above or to combine Ramasubramani and Parthasarathy for the reason discussed above. Also, there is no motivation to combine Ramasubramani and Parthasarathy with Bakshi. These combinations are improperly based on the hindsight of Applicants' disclosure. Such hindsight reconstruction of the art cannot be the basis of a rejection under 35 U.S.C. 103. The prior art itself must suggest that modification or provide the reason or motivation for making such modification. In re Laskowski, 871 F.2d 115, 117, 10 USPQ 2d 1397, 1398-1399 (CAFC, 1989). "The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made." Sensonics Inc. v. Aerosonic Corp. 38 USPQ 2d 1551, 1554 (CAFC, 1996), citing Interconnect Planning Corp. v. Feil, 774 F. 2d 1132, 1138, 227 USPQ 543, 547 (CAFC, 1985).

For the reasons set forth above, it is submitted that claim 4 is distinguished from Ramasubramani, Parthasarathy and Bakshi, taken separately or in the combinations suggested by the Examiner.

For the reason set forth above, it is submitted that the rejection of claim 4 under 35 U.S.C. 103(a) is inapplicable and should be withdrawn.

The Office Action rejects claims 5 and 7 under 35 U.S.C 103(a) as unpatentable over Ramasubramani in view of Parthasarathy as applied to claim 1 and further in view of U.S Patent No. 6,560,717 to Scott et al., hereafter Scott.

Since claims 5 and 7 depend from amended claim 1, this rejection is inapplicable for the same reason set forth in the discussion of amended claim 1.

For the reason set forth above, it is submitted that the rejection of claims 5 and 7 under 35 U.S.C. 103(a) is inapplicable and should be withdrawn.

The Office Action rejects claim 6 under 35 U.S.C 103(a) as unpatentable over Ramasubramani in view of Parthasarathy and Scott and further in view of U.S Patent No. 6,138162 to Pristriotto et al., hereafter Pristriotto.

Since claim 6 depends from amended claim 1, this rejection is inapplicable for the same reason set forth in the discussion of amended claim 1.

For the reason set forth above, it is submitted that the rejection of claim 6 under 35 U.S.C. 103(a) is inapplicable and should be withdrawn.

The Office Action rejects claim 8 under 35 U.S.C 103(a) as unpatentable over Ramasubramani in view of Parthasarathy, Scott and Pristriotto and further in view of U.S Patent No. 6,442,588 to Clark et al., hereafter Clark.

Since claim 8 depends from amended claim 1, this rejection is inapplicable for the same reason set forth in the discussion of amended claim 1.

For the reason set forth above, it is submitted that the rejection of claim 8 under 35 U.S.C. 103(a) is inapplicable and should be withdrawn.

The Office Action rejects claim 9 and 11 under 35 U.S.C 103(a) as unpatentable over Ramasubramani in view of Parthasarathy and Scott as applied to claim 5 and further in view of U.S Patent No. 6,078,955 to Konno et al., hereafter Konno.

Since claims 9 and 11 depend from amended claim 1, this rejection is inapplicable for the same reason set forth in the discussion of amended claim 1.

For the reason set forth above, it is submitted that the rejection of claims 9 and 11 under 35 U.S.C. 103(a) is inapplicable and should be withdrawn.

The Office Action rejects claim 10 and 12 under 35 U.S.C 103(a) as unpatentable over Ramasubramani in view of Parthasarathy, Scott and Konno as applied to claim 9 and further in view of Clark.

Since claims 10 and 12 depend from amended claim 1, this rejection is inapplicable for the same reason set forth in the discussion of amended claim 1.

For the reason set forth above, it is submitted that the rejection of claims 10 and 12 under 35 U.S.C. 103(a) is inapplicable and should be withdrawn.

Newly presented claim 17 recites a combination of claims 1, 2, 4 and 5 and is distinguished from the applied references for the some reasons discussed in the observations of amended claim 1. Additionally, the applied references do

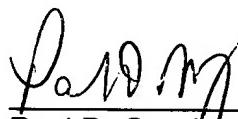
not teach the additional elements of claims 4 and 5. Accordingly, it is submitted that claim 17 distinguishes from the cited art and is, therefore, allowable.

It is respectfully requested for the reasons set forth above that the rejections under 35 U.S.C. 103(a) be withdrawn, that claims 1 and 4-17 be allowed and that this application be passed to issue.

For the reasons set forth above, it is submitted that this amendment places the application in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and passed to issue. If this amendment is deemed to not place the application in condition for allowance, it is respectfully requested that it be entered for the purpose of appeal.

Respectfully Submitted,

Date: 10/29/04



Paul D. Greeley  
Reg. No. 31,019  
Attorney for Applicants  
Ohlandt, Greeley, Ruggiero & Perle, L.L.P.  
One Landmark Square, 10<sup>th</sup> Floor  
Stamford, CT 06901-2682  
(203) 327-4500